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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,815	10/19/2001	Anthony Kevin Carbone		7562

7590 05/27/2005

ANTHONY K. CARBONE  
17534 RAVEN ROCKS ROAD  
BLUEMONT, VA 20135

EXAMINER
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LAM, ANDREW H

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 05/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/981,815

Applicant(s)

CARBONE, ANTHONY KEVIN

Examiner

Andrew H. Lam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☒ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) ✓
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/19/2001. ✓
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Priority***

This application is claiming the benefit of a prior filed non-provisional application under 35 U.S.C. 120, 121, or 365(c). However, in review of the Oath the application did not claim priority to the non-provisional application, which is a continuation of this application. Therefore, priority is not granted for this application.

### ***Information Disclosure Statement***

The information disclosure statement for non patent literature documents filed 10/19/2001 fails to comply because it lacks the following format: name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published. It has been placed in the application file, but the information referred to therein has not been considered.

### ***Claim Objections***

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Applicant has two claims labeled "claim 2". Correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 16-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 16, the claim recites "server system can retrieve unique data from the client system when the client system is not connected to the server system for the purpose of sending the collected information to the server system at a time determined by the requester for the purpose of reducing costs associated with maintaining a connection to the server system". The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not provide an adequate written description of how the server system can retrieve data from the client system when the client system is not connected to the server system.

Regarding claim 17, which depends on claim 16, the claim recites "server system can send to the client system a standalone executable software element that permits the client system to collect and change the unique data without connection to the server system". The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or

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with which it is most nearly connected, to make and/or use the invention. The specification does not provide an adequate written description of how the server system can send to the client system a standalone executable software element that permits the client system to collect and change the unique data without connection to the server system.

Regarding claim 18, which depends on claim 17, it inherits the deficiency of the claim 17 discussed above.

Regarding claim 19, which depends on claim 16, the claim recites "client system can connect or reconnect to the server system for the purpose of sending to the server system unique data that was collected or changed while the client system was not connected to the server system". The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not provide an adequate written description of how the client system can connect or reconnect to the server system for the purpose of sending to the server system unique data that was collected or changed while the client system was not connected to the server system.

Regarding claim 20 and 21, which depend on claim 16, they inherit the deficiency of the claim 16 discussed above.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-15 are rejected under 35 U.S.C. 102(e) as being anticipated Arledge, Jr. et al (U.S. 6535294).

Regarding claim 1, Arledge, Jr. discloses a method of collecting and combining a plurality of unique individualized datum under control of a client system (fig. 1, a system for preparing a customized printed product over Internet--client system 101),

a) on forms system (col. 3, lines 55-61, the end-user is guided through a design and layout process comprising a series of conventional, interconnected screens, windows, menus, fields, text entry boxes, and the like, which cooperate with one another to enable the end-user to define the type, design, style and layout of the customized printed product on the client computer 101 ) presented to the client system from the server system (col. 3, line 40, the client is connected to the wholesale web server computer 140) a communications link (col. 7, line 62, the client computer 101 connects to the Internet 50),

b) recording records of unique individualized data on the server system database (col. 5, line 4-10, the end-user customized print products data is save in the database—col. 3, lines 55-61, the user is presented with a layout process which he/she can uniquely customize the products with individualized text and art work

for the printed product, see fig. 2); and

c) displaying (col. 15, lines 44-49, the end-user can display the design layout), editing (col.15, lines 50-54, the end-user can customize the layout of the specified product), and combining that data in a multiplicity of ways (col. 15, lines, 67,col. 16, lines 1-27, the customized image template is initially a blank image, the customer can “add text”, “add art”, “delete”, “undo”, and “redo”--when the user clicks on add text the customer is presented with text to be added to the image template--when the user clicks on add image the customer is presented with image to add to the template or upload the image--see fig. 10, therefore he/she is combining the data in a multiplicity of ways); and

d) printing that data such that each printed item is unique (col. 19, line 56, wholesaler to prepare and print the customized product).

Regarding claim 2, Arledge, Jr. discloses the method of claim 1 wherein the raw printable stock is an inventory of the server system (col. 15, lines 5-10, the wholesaler have sufficient means and equipment to produce printed products--col. 16, line 65-67, the product ID relating to the selected product is stored in the orders database).

Regarding claim 2 (second occurrence), Arledge, Jr. discloses the client system of claim 1 wherein the display component on the client system is a browser (col. 12, lines 25-26, the client direct the Internet browser installed on the user's client computer to retailer's web site).

Regarding claim 3, Arledge, Jr. discloses the method of claim 1 wherein the displaying includes displaying an HTML document provided by the server system to the

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client system (col. 12, line 30-32, displaying the HTML file associated with the retailer's so-called web site "home page" 300 on the video display of the end-user's client computer 101).

Regarding claim 4, Arledge, Jr. discloses the method of claim 1 wherein the displaying and printing of the unique item includes adding non-unique data previously stored on the server system (col. 16, lines 9-12, the user can add available graphic images and artwork from a list that is stored on the database--it is non-unique because it is available to all customer).

Regarding claim 5, Arledge, Jr. discloses the method of claim 1 wherein the product is two or more items wherein the content printed on the items is unique from item to item (col.16, lines 44-57, the user can place one order of the product which is unique once the user clicks the place order in shopping cart button, therefore displaying all the product the user have placed during the user's session. If the user wishes to place another order he/she can select the "order more product" or the "like" button, at which point the user is return to choose the product screen and the process of customizing of the same product with different content is repeated).

Regarding claim 6, Arledge, Jr. discloses the method of claim 1 wherein the unique data (col. 15, lines 39-40, the user can "upload" artwork from the end-user's computer--the artwork is company logo or original artwork) is supplied by the client system; and wherein that unique data is not a pointer to or makes reference to non-unique data stored on the server system (col. 16, lines 9-12, user can "add art" to the



template which is the original artwork that the user has "uploaded" into the artwork database).

Regarding claim 7, Arledge, Jr. discloses the method of claim 1 wherein the print quantity is directly related to the number of records of unique data in the server system database (col. 16, lines 48-50, a display list show all the customized printed products being ordered during the user's session--col. 16, lines 30-34, saving the customized design and layout of the printed product, including order information and is associated with the user's account--information is store in the order database).

Regarding claim 8, Arledge, Jr. discloses the method of claim 1 wherein the unique data can be applied to different physical sizes and shapes of printed items (col. 15, lines 4-7, specialty printed products, such as rubber stamps, calendars, tee shirts, and the like).

Regarding claim 9, Arledge, Jr. discloses the method of claim 1 wherein the unique data can be modified by other data, which may either be constant or unique (col. 16, lines 1-6, the text is unique data supplied by the user however it can be modified by the which is can be unique or constant base on the user.

Regarding claim 10, Arledge, Jr. discloses the method of claim 1 wherein typographical attributes of the printed data can vary based on criteria specified by choices on forms displayed by the client system (col. 16, line 4, a list of selectable font size).

Regarding claim 11, Arledge, Jr. discloses the method of claim 1 wherein the server system for generating the printing uses a data storage medium storing

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information for a plurality of users (col. 9, line 59-66, the information database includes a customer database for containing information relating to the registered end-users); and a receiving component for receiving requests to collect, display, and print items, a request including an indication of one of the plurality of users (fig. 2, the preparation system 201 contain customer database 224 to collect, html file 261 to display, orders database 222 to order the product to be printed and customer database 224 to store the plurality of users information) .

Regarding claim 12, Arledge, Jr. discloses the method of claim 1 wherein the client system can request the server system to print selected items or all items at different times (col. 16, lines 50-53, the user can discard a selected product for the shopping cart list--the shopping cart list contain all the product the user want to print).

Regarding claim 13, Arledge, Jr. discloses the method of claim 1 wherein the items to be printed are related and have associated dependencies (col. 16, lines 63-65, the user may add related products).

Regarding claim 14, Arledge, Jr. discloses the method of claim 1 wherein content (col. 15, lines, 34-43, the user can upload artwork into the which can be use for present or future orders), attributes (col. 15, lines 20-25, the user is present with a selection screen to select the thickness of the paper, the color, and the size desired), and quantities (col. 15, lines19-20, the user is present with a selection screen to select the quantities desired) of subsequently printed items are dependent on either user changes or decisions or variables associated with previously printed items (col. 13,

lines 24-29, if the user's is registered in the database certain end-user defaults such as previously-ordered customized products can be access by the user).

Regarding claim 15, Arledge, Jr. discloses the method of claim 1 wherein content (col. 15, lines, 34-43, the user can upload artwork into the which can be use for present or future orders), attributes (col. 15, lines 20-25, the user is present with a selection screen to select the thickness of the paper, the color, and the size desired), and quantities (col. 15, lines 19-20, the user is present with a selection screen to select the quantities desired) of subsequently printed items are dependent on variables of previously printed items (col. 13, lines 24-29, if the user's is registered in the database certain end-user defaults such as previously-ordered customized products can be access by the user).

Regarding claim 16, Arledge, Jr. discloses the method of claim 1 wherein the server system can retrieve unique data from the client system when the client system is not connected (col. 19, lines 44-47, once the client places the unique customize order he/she can disconnect from the wholesaler web server computer) to the server system for the purpose of sending the collected information to the server system at a time determined by the requester for the purpose of reducing costs associated with maintaining a connection to the server system.

Regarding claim 19, Arledge, Jr. discloses the method of claim 16 wherein the client system can connect or reconnect to the server system for the purpose of sending to the server system unique data that was collected or changed while the client system was not connected to the server system (col. 19, lines 44-47, once the client places the

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unique customize order he/she can disconnect from the wholesaler web server computer--since the user can disconnect he/she can reconnect to the server by login to the system again).

Regarding claim 20, Arledge, Jr. discloses the method of claim 16 wherein the content of the unique items can only be modified by or changed by content residing solely on the server system prior to printing (col. 21, lines 48-52, management server computer 280, where the image of the customized printed product is automatically formatted with reference to the information database 287 to prepare the file for printing).

Regarding claim 21, Arledge, Jr. discloses the method of claim 20 wherein the client system and server system communicate via the Internet (fig. 1, internet connection 50).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17 and 18, rejected under 35 U.S.C. 103(a) as being unpatentable over Arledge, Jr. in view of Cheng et al (U.S. 6012070).

Regarding claim 17, Arledge, Jr. discloses the method of claim 16 wherein the server system can send to the client system software element that permits the client system to collect and change the unique data with connection to the server system.

Arledge, Jr. does not disclose expressly that the system is a stand-alone executable software element that permits the client system to collect and change unique data without the connection to the server system.

Cheng disclose a stand-alone system where a client can uniquely customize the data that is to collect and change data using an off the shelf software, such as Adobe PageMaker without the connection to the server system (col. 1, lines 50-53).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Arledge, Jr. as per teaching of Cheng because of the following reason: by sending the client a stand-alone executable software element such as Adobe PageMaker--the client can collect and make changes to the unique data and saving it to the client system. By having the software at the client system the user can create customize, quality documents at the end user's convenience (col. 1, lines 25-29).

Regarding claim 18, Arledge, Jr. discloses the client system of claim 17 wherein the data entry and display component is web browser software element.

Arledge, Jr. does not disclose expressly that data entry and display component is a stand-alone executable software element.

Cheng disclose a stand-alone system where a client can uniquely customize the data that is to collect and change data using an off the shelf software, such as Adobe PageMaker without the connection to the server system (col. 1, lines 50-53).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Arledge, Jr. as per teaching of Cheng because of the

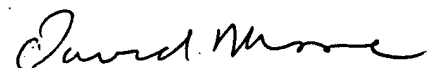
following reason: by sending the client a stand-alone executable software element such as Adobe PageMaker--the client can collect and make changes to the unique data and saving it to the client system. By having the software at the client system the user can create customize, quality documents at the end user's convenience (col. 1, lines 25-29).

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew H. Lam whose telephone number is (571) 272-8569. The examiner can normally be reached on M-F (9:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**DAVID MOORE**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2600**

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